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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE:

APPLICANT; WILLIAM M. HAMMESFAHR

S.N.: 09/841,546

GROUP ART UNIT: 3768

FILED: 04/23/2001

EXAMINER: FRANCIS JAWORSKI

FOR: A TITRATION SYSTEM FOR TREATING
CEREBRAL VASOSPASMS

ATTY DOC NO. 2087.1

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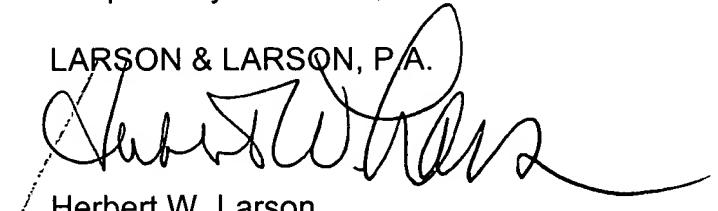
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S BRIEF ON APPEAL

The enclosed three copies of the brief with Appendix are substitutes for the previously filed brief. A substitute brief was requested in the Office Action dated May 21, 2007.

Respectfully submitted,

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APPLICANT'S BRIEF ON APPEAL

I. Real Party in Interest is:

Dr. William M. Hammesfahr
Hammesfahr Neurological Institute
600 Druid Road East
Clearwater, FL 33736

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. STATUS OF CLAIMS

There are seven (7) pending claims in the subject application numbered 38-44 under final rejection. Claims 1-37 were cancelled during prosecution. All seven (7) pending claims numbered 38-44 are the subject of the appeal herein.

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In the final office action dated October 31, 2006, the Examiner sets forth two grounds for rejection.

First, the Examiner rejects Claims 38-44 under 35 U.S.C. § 112 as being indefinite.

Secondly, the Examiner rejects Claims 38-44 under 35 U.S.C. § 103(a) as being unpatentable over Shaw et al. (U.S. Patent 4,650,484) in view of Stanley et al. (U.S. Patent 4,885,173), Fung et al. (U.S. Patent 5,278,192) and Ragauskas et al. (U.S. 5,388,583).

IV. STATUS OF AMENDMENTS

There were no amendments filed after the final rejection dated October 31, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention of Claim 38 is a titration system for treating a disease caused by insufficient cerebral perfusion. The system employs a flow measuring device to test for cerebral vasospasms (page 4, lines 17-19), a dosage device that administers a vasospasm reducing dosage of a particular medicine with the dosage device being adjustable over time to titrate the dosage either upwards or downwards or substitute another medicine to minimize severity of the vasospasm (page 7, lines 26-31).

The invention of Claim 39, incorporating all of the limitations of Claim 38, identifies the flow measuring device comprising transcranial Doppler measuring means (page 3, lines 2-4 and Fig. 1).

The invention of Claim 40, incorporating all of the limitations of Claim 38,

adding the feature that the dosage device comprises a means for delivering a vasodilator selected from the group comprising Nitroglycerin in pill, patch, ointment, cream, inhaler, spray and other forms (page 3, lines 28-95; page 5, lines 2-4). The Nitroglycerin equivalents and substitutes, comprising p.o. clonidine, isradipine, hydrazine, nifedipine and/or other medicines (page 5, lines 5-6) selected from the empirical group of medications which have the common characteristics of causing smooth muscle relaxation and/or which systematically reduce pulmonary capillary wedge pressure and combinations of the foregoing (page 7, lines 11-15).

The invention of Claim 41, incorporating all of the limitations of Claim 38, adding the feature of a low measuring device comprising transcranial Doppler measuring means (page 3, lines 2-4) and the dosage device comprises transdermal, inhaler, spray and other forms of vasodilators selected from the group consisting of Nitroglycerine equivalents and substitutes, p.o. clonodine, isradipine, hydrazine, nifedipine and/or other medicines selected from the empirical group of medications which have the common characteristics of causing smooth muscle relaxation and which systematically reduce pulmonary capillary wedge pressure and combinations of the foregoing (page 5, lines 5-6 and page 7, lines 11-15).

The invention of Claim 42, incorporating all of the limitations of Claim 41, adding the feature that the delivery device comprises means for delivering a vasodilator selected from the group comprising Nitroglycerin in pill, patch, ointment or cream form (page 5, lines 2-4).

The invention of Claim 43, incorporating all of the limitations of Claim 46 [sic 41] adds the feature that the delivery system is adapted for transdermal delivery

(page 8, line 24).

The invention of Claim 44, incorporating all of the limitations of Claim 38, adds the feature that the delivery system is adapted for the adjustment of the dosage device over time within the range of about 0.02 to 20 milligrams per day (Nitroglycerin equivalent) of vasodilator (page 7, lines 21-23).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(1) Whether Claims 38-44 are indefinite within the meaning of 35 U.S.C. § 112, second paragraph.

(2) Whether Claims 38-44 are obvious within the meaning of 35 U.S.C. § 103(a) over Shaw et al. (U.S. Patent 4,650,484) in view of Stanley et al. (U.S. Patent 4,885,173, Fung et al. (U.S. Patent 5,278,192 and Ragauskas et al. (U.S. Patent 5,388,583).

Since Claims 39-44 are dependent from independent Claim 38; if Claim 38 is allowable then all seven Claims 38-44 are allowable. Since Claims 42 and 43 are dependent on Claim 41; if Claim 41 is allowable, then all three Claims 41-43 are allowable.

As stated above, Claim 38 is independent and Claim 39 is dependent on Claim 1. However, Claim 39 stands alone and would be patentable, as discussed in Arguments set forth below, even if Claim 38 is found unpatentable. Claim 40 is dependent on Claim 38. However, Claim 40 also stands alone and would be patentable, as discussed in the Arguments set forth below, even if Claim 38 is found unpatentable. Claim 41 is dependent on Claim 38. However, Claim 41 stands alone and would be patentable, as discussed in the Arguments set forth below, even if

Claim 38 is found unpatentable. Claim 42 is dependent on Claim 41. However, Claim 42 also stands alone and would be patentable, as discussed in Arguments set forth below, even if Claim 41 is found unpatentable. Claim 43 is dependent on Claim 41. However, Claim 43 stands alone and would be patentable, as discussed in the Arguments set forth below, even if Claim 41 is found unpatentable. Claim 44 is dependent on Claim 38. However, Claim 44 also stands alone and would be patentable, as discussed in the Arguments set forth below, even if Claim 38 is found unpatentable.

VII. ARGUMENT

(i) Claims 38-44 are definite within the meaning of 35 U.S.C. § 112, second paragraph.

The Examiner has rejected Claims 38-44 under 35 U.S.C. § 112, second paragraph, as being indefinite. All of Claims 38-44 are directed to a titration system for diagnosing and treating a disease. One element in the system is a flow measuring device to test for cerebral vasospasms. A second is a dosage device which administers a vasospasm reducing dosage. The dosage device is adjustable over time to titrate the dosage in response to testing to increase, decrease or substitute another medicine. The Examiner is correct that a decision has to be made by a practitioner as whether to increase, decrease or substitute another medicine. The fact is that the system provides for the capability for the practitioner to make that decision. Applicant is not claiming the input of a specific practitioner, but is claiming a system which is adapted to receive such input. As such it is not believed that Claims 38-44 are indefinite.

(ii) Claims 38-44 are not obvious in view of the cited prior art

The Examiner further rejected Claims 38-44 under 35 U.S.C. § 103. This rejection includes four references Shaw et al., Stanley et al., Fung et al. and Ragauskas et al. Shaw et al. describes a method for treating ischemic conditions by administering a vasodilator to a patient continuously without intermediate testing at a rate of from 10 micrograms to 400 micrograms per hour. There is no suggestion that the dosage is adjusted over time to titrate the dosage to minimize severity of a vasospasm.

Stanley et al. describes a sustained lollipop delivery vehicle for cardiovascular or renal vascular activities. Stanley et al. is not directed to cerebral vasospasms and does not suggest that the dosage can be adjustable over time in response to titration testing.

Fung et al. is directed to a treatment for congestive heart failure and is not concerned with cerebral vasospasms. Furthermore, Fung et al. only increases dosages until angina is effectively controlled. There is no suggestion that dosages are adjusted to minimize occurrence and severity of a vasospasm.

Ragauskas et al. suggests the possibility of evaluating cerebral vasospasm using ultrasonic pulses within the intracranial medium.

Taking Shaw et al, Stanley et al., Fung et al. and Ragauskas et al. together and considering them as a whole, they describe treating ischemic conditions by administering a vasodilator over sustained periods of time with increasing dosage and evaluating cerebral vasospasms with ultrasonic pulses. In contrast, applicant's invention of independent Claim 38 is directed to a titration system for treating a

disease caused by insufficient cerebral profusion; the system employing: (1) a flow measuring device to test for cerebral vasospasms, (2) a dosage device which administers a vasospasm reducing dosage of a particular medicine and (3) the dosage device being adjustable over time to titrate the dosage either upwards or downwards or substitute another medicine to minimize severity of the vasospasm. Applicant's treatment relies on the adjustable dosage based on titration of the dosage and changes made as necessary. The prior art in combination does not describe such an invention.

In addition, it is noted that the Examiner has picked and chosen portions of four references in order to attempt to support an argument that applicant's Claim 38 is obvious. In fact the four references as a whole do not teach applicant's titration system. Nevertheless, the Court of Appeals for the Federal Circuit has stated, "it is impossible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that one cannot use hind sight reconstruction to pick and chose among isolated disclosures in a prior art to deprecate the claimed invention." See *In re Fritch* 23 USPQ 2nd 1780, 1784 (Fed. Cir. 1992). See also, *Ruiz v A.B. Chance Co.* 69 USPQ 2nd 1686 (Fed. Cir. 2004).

Of the references cited, only Shaw et al. and Ragauskas et al. even relate to vasospasms. These references together do not teach applicant's invention of Claim 38. The other references are not even concerned with cerebral vasospasms and should not be used in an obviousness rejection.

Taking all four references cited together as a whole and considering them as

a whole they do not teach applicant's invention of Claim 38 and do not make such claim obvious within the meaning of U.S.C. § 103(a). Therefore, the rejection of Claim 38 should be overruled.

With respect to Claim 39, the four references as a whole do not teach a titration system as set forth in Claim 38 wherein the flow measuring device is a transcranial Doppler measuring means.

With respect to Claim 40, the four references as a whole do not teach a titration system as set forth in Claim 38 wherein the dosage device is a means for delivering a vasodilator selected from the group of a nitroglycerin in pill, patch, ointment, cream, inhaler and spray form, clonidine, isradipine, hydrazine, nifedipine.

With respect to Claim 41, the four references as a whole do not teach a titration system as set forth in Claim 38 wherein the flow measuring device is a transcranial Doppler measuring means and the dosage device is a transdermal, inhaler, spray form of vasodilator selected from the group consisting nitroglycerin, clonidine, isradipine, hydrazine and nifedipine.

With respect to Claim 42, the four references as a whole do not teach a titration system as set forth in Claim 41 wherein the delivery device is a means for delivering a nitroglycerin vasodilator in pill, patch, ointment or cream form.

With respect to Claim 43, the four references as a whole do not teach a titration system as set forth in Claim 41 wherein the delivery system is adapted for transdermal delivery.

With respect to Claim 44, the four references as a whole do not teach a titration system as set forth in Claim 38 wherein the delivery system adjusts the

dosage device within the range of 0.02 to 20 milligrams per day of a vasodilator.

If follows that the rejection of Claims 39-44, like Claim 38, should be overruled.

CONCLUSION

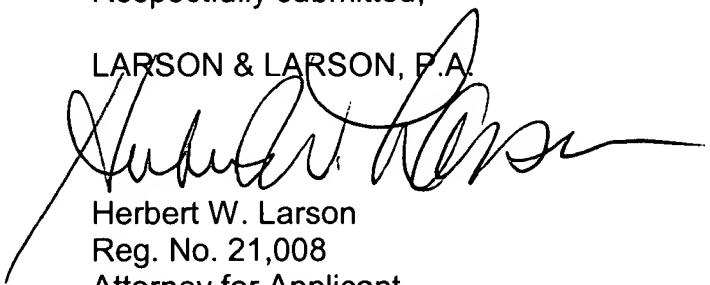
(1) The claims are definite for the purpose to which they are presented and therefore the rejection under 35 U.S.C. § 112 should be reversed.

(2) The rejection of Claims 38-44 should be reversed because the four references taken as a whole fail to make the claims obvious within the meaning of 35 U.S.C. § 103(a).

Kindly deduct the \$250.00 Appeal Fee from Deposit Account No. 12-0551 in the name of Larson & Larson, P.A.

Respectfully submitted,

LARSON & LARSON, P.A.



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VIII. CLAIMS APPENDIX

38. A titration system for diagnosing and treating a disease caused at least partially by insufficient cerebral perfusion, comprising in combination: a flow measuring device to test for cerebral vasospasm, a dosage device which administers a vasospasm-reducing dosage of a medicine selected from the empirical group of medications which have the common characteristic of causing smooth muscle relaxation and/or which reduce pulmonary capillary wedge pressure, and said dosage device being adjustable over time to titrate said dosage in response to said testing to increase, decrease or substitute another medicine to minimize occurrence and severity of said vasospasm.
39. A system according to Claim 38 wherein the flow measuring device comprises transcranial Doppler measuring means.
40. A system according to Claim 38 wherein the dosage device comprises means for delivering a vasodilator selected from the group comprising Nitroglycerin in pill, patch, ointment, cream, inhaler, spray and other forms, Nitroglycerin equivalents and substitutes, comprising p.o. clonidine, israpidine, hydrazine, nifedipine, and/or other medicines selected from the empirical group of medications which have the common characteristic of causing smooth muscle relaxation and/or which systemically reduce pulmonary capillary wedge pressure, and combinations of the foregoing.
41. A system according to Claim 38 wherein the flow measuring device comprises transcranial Doppler measuring means and the dosage device comprises transdermal, inhaler, spray and other forms of vasodilator selected from the group consisting of Nitroglycerin, Nitroglycerin equivalents and substitutes, p.o. clonidine,

isradipine, hydrazine, nifedipine, and/or medicines selected from the empirical group of medications which have the common characteristic of causing smooth muscle relaxation and/or which systemically reduce pulmonary capillary wedge pressure, and combinations of the foregoing.

42. A system according to Claim 41 wherein the delivery device comprises means for delivering a vasodilator selected from the group comprising Nitroglycerin in pill, patch, ointment or cream form.

43. A system according to Claim 46 wherein the delivery system is adapted for transdermal delivery.

44. A system according to Claim 38 wherein the delivery system is adapted for the adjusting of the dosage device over time within the range of about 0.02 to 20 milligrams per day (Nitroglycerin equivalent) of vasodilator.

IX. EVIDENCE APPENDIX

<u>Patent</u>	<u>Page</u>
Shaw et al., U.S. Patent 4,650,484	5, 6
Stanley et al., U.S. Patent 4,885,173	5, 6
Fung et al., U.S. Patent 5,278,192	5, 6
Ragauskas et al., U.S. Patent 5,388,583	6
In re Fritch 23 USPQ 2 nd 1780, 1784 (Fed. Cir. 1992)	7
Ruiz v A.B. Chance Co. 69 USPQ 2 nd 1686 (Fed. Cir. 2004)	7

X. RELATED PROCEEDINGS APPENDIX

There are no related decisions rendered by a Court or the Board to the Claims at issue in this proceeding.

In re Fritch
No. 91-1318
Decided August 11, 1992

DICIAL PRACTICE AND PROCEDURE

Procedure — Judicial review — Standard of review — Patents (§410.4607.09)

Obviousness determination is based on underlying factual inquiries concerning the invention, and prior art, which are reviewed for clear error on appeal, but ultimate conclusion of obviousness is reviewed by the Board.

TENTS

Patent construction — Claims — Broad or narrow (§125.1303)

Charles L. Gholtz, of Oblon, Spivak, McClelland, Maier & Neustadt, Arlington, Va. (John R. Fritch, Corpus Christi, Texas, on brief), for appellant.

Jameson Lee, associate solicitor (Fred E. McKelvey, solicitor, with him on brief; Richard E. Schaefer, of counsel), for appellee.

Before Smith, senior circuit judge, and Plager and Rader, circuit judges.

Smith, J.

John R. Fritch (Fritch) appeals the February 1991 decision of the Patent and Trademark Office Board of Patent Appeals and Interference (Board) affirming-in-part the Examiner's final rejection of the remaining claims in Fritch's application, entitled "Landscape Edging Apparatus and Method." The Examiner concluded that Fritch's invention would have been obvious to one of ordinary skill in the art and was therefore unpatentable under 35 U.S.C. § 103. The Board, except for allowing claim 28, agreed. The Board's decision is reversed.

Patentability/Validity — Obviousness — Combining references (§115.0905)

Claims for landscape edging device are prima facie obvious in view of combined teachings of two prior patents, since primary reference does not suggest overall flexibility of landscape retention function of claimed device, and since secondary reference does merely by virtue of flexibility of device described therein, suggest extensive modifications which would bring primary reference to conformity with application claims.

Patentability/Validity — Obviousness — Combining references (§115.0905)

Mere fact that prior art may be modified reflect features of claimed invention does make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by prior art; claimed invention cannot be used as instruction manual or "template" to piece together changes of prior art so that claimed invention is rendered obvious.

the subject matter of independent claims 1, 13, 24, and 29 obvious to one of ordinary skill in the art. Fritch does not appeal the Board's disposition as to claims 27 and 28, and at oral argument withdrew the appeal as to claim 8. The claims remaining in this appeal are 1-7, 9-24, 29 and 30...

The Fritch Invention

The invention claimed by Fritch involves a landscape edging device which includes a planar base portion and an upwardly extending retaining portion. The base portion is elongate, thin, flexible and has a planar bottom surface conformable to a varying slope ground surface. One longitudinal edge of the base portion serves as a mowing strip and the other serves as a retaining flange for landscape fill. The upwardly extending retaining portion is integrally connected (e.g., fused) to the base portion, and defines a longitudinally extending enclosed space. The Fritch invention is intended to be used as a retainer for landscape fill in order to separate unmovable landscape fill from the mowable lawn. It may also be used to secure a landscaping sheet to the ground, or to function as guards at the base of a fence. Independent claims 1 and 13 on appeal are representative of the subject matter claimed:

1. A landscape edging strip formed in its entirety of a thin gauge, flexible material and conformable to a ground surface of varying slope, comprising a continuous elongate, thin gauge, flexible base portion having a planar bottom surface conformable to said varying slope ground surface; a thin gauge, elongate, retainer portion integral with said base portion and extending upwardly therefrom and transversely thereof to overlie a portion of said base portion; all of said retainer portion defining a longitudinally extending enclosed space; said retainer portion being integrally connected to said base portion adjacent one longitudinal edge of said base portion to define a mowing strip adjacent the other longitudinal edge of said base portion.

Background

In his final rejection, the Examiner rejected claims 1-24 and 27-30 of Fritch's application as unpatentable for obviousness under 35 U.S.C. § 103. Fritch appealed the final rejection to the Board. The Board affirmed the rejection as to claims 1, 24, 29 and 30, entered a new ground of rejection for claim 27, and reversed as to claim 28. The Board agreed with the Examiner that the teachings of the Wilson and Hendrix patents rendered

The Prior Art

a. The Wilson Patent

The Wilson patent relied upon by the Examiner and the Board is entitled "Grass Edging and Watering Device". The embodiment of the Wilson device includes a substantially flat mowing strip extending horizontally from a longitudinally extending body portion. Opposite the mowing strip is a scored flange which may be broken off when not needed or wanted. Between the mowing strip and the flange, and extending vertically from the body portion is an anchoring leg. Located above the anchoring leg is the body portion which contains a water conduit and sprinkler head assembly. The device is intended to be used adjacent to the borders of walks and plant beds. Figures 1 and 4 from Wilson's drawings are reproduced below:

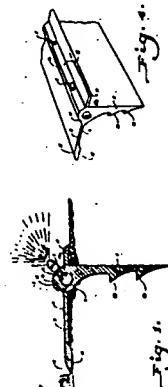


FIG. 1

13. A landscape edging strip formed in its entirety from thin gauge, flexible material and conformable to a ground surface of varying slope, comprising a continuous elongate, thin gauge, flexible base portion having a planar bottom surface conformable to said varying slope ground surface.

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[1] "Obviousness is a question of law to be determined from the facts"; The obviousness determination "is based upon underlying factual inquiries concerning the claimed invention and the prior art" which are reviewed for clear error.⁶ However, it is the ultimate conclusion of obviousness which the Federal Circuit reviews as a matter of law.⁷



The Hendrix Patient

The Hendrix patent is entitled "Loose Material Retainer Strip". The Solicitor those not to discuss the Hendrix reference in his brief, stating that the Board had deemed Hendrix unnecessary to its decision. The solicitor overstates the Board's position. The Board based its decision upon "a collective evaluation of the Wilson and Hendrix patents". We include Hendrix in our discussion because it did play a role in the rejection of

The Hendrix device is composed of elongated, flexible strips having substantially U-shaped cross-section. The bottom lip of the device is to be wider than the top lip in order to facilitate fastening the device to the ground. The device will fit most gentle contours, and the top lip will yield laterally to the build-up of gravel until the gravel can be redistributed. The concave portion of the strip is installed such that it faces the material to be retained in place. Hendrix contemplates that the retainer will be used in retaining gravel in driveways, lining flower beds, or on the shoulders of asphalt or concrete highways. Figure 1 of Hendrix's drawings is reproduced below:

Standard of Review

[1] “[O]bviousness is a question of law to be determined from the facts.”⁵ The obviousness determination “is based upon underlying factual inquiries concerning the claimed invention and the prior art” which are reviewed for clear error.⁶ However, it is the ultimate conclusion of obviousness which the Federal Circuit reviews as a matter of law.⁷

Teachings of Wilson

Fritch takes exception to the Examiner's findings of fact related to the teachings of the Wilson patent. The Examiner's rejection and the Board's opinion rely heavily on the use of Wilson in view of other references to declare the Fritch invention obvious. The Board states that it agrees with the Examiner's finding of fact regarding the teachings of Wilson. In the Examiner's answer, which the Board quotes, the Wilson device is described

The Board states that the Wilson reference presents "substantial evidence that Wilson is both thin and flexible." The Board regards the Wilson device as teaching that it is flexible and conformable in its entirety. This as follows:

[2] It is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art.¹ The base portion of Wilson is not planar in its entirety, as the Board's opinion suggests, but also includes a prominent anchoring leg to secure the device to the ground. The anchoring leg, which runs the length of the Wilson device, would inhibit longitudinal flexibility of the Wilson device. Indeed, Wilson expressly contemplates flexibility and conformability *only* in the "mower strip." Wilson states that its "mower strip may be lifted in order to pack dirt thereunder for the purpose of securing the device to the ground. Fritch, on the other hand, is claimed to be flexible in its entirely.

³ *In re De Blauwe*, 736 F.2d 699, 703, 222 USPO 191, 195 (Fed. Cir. 1984).

USPQ 191, 193 (Fed. Cir. 1984);
In re Kulling, 897 F.2d 1147, 1149, 14
 USPQ2d 1056, 1057 (Fed. Cir. 1990).

USPQ2d 1036, 1051 (CC, Ch., 12/27/1995).
In re De Blauwe, 736 F.2d at 703, 222 USPQ at 195.

The Board's holding that Wilson is flexible in its entirety is based upon a misapprehension of the scope of Wilson's teachings.

Second, Wilson's anchoring leg prohibits conformability to the ground surface in the manner claimed by Fitch. The Examiner's description of Wilson as having a "planar bottom surface conformable to a varying slope surface" is applicable *only* in reference to the mower strip. This description, however, ignores the anchor leg and the fact that it must be placed *into* the ground. Wilson expressly teaches that the anchoring leg may be pushed into soft soils, but in harder terrain a trench is needed in order to place the

the Wilson apparatus, the ground surface must be altered to conform to the device rather than, as the Solicitor contends, that Wilson is freely conformable to the ground. Fritch, on the other hand, does not require such extensive alteration of the ground surface in order to install the device.

Prima Facia Obviam

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art.⁹ [The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.¹⁰ The applicant may then attack the Examiner's prima facie determination as impropperly made out, or the applicant may present objective evidence tending to support a con-

clusion of nonobviousness." Fritch has attacked the Board's finding that the Examiner established that Fritch's claimed invention was *prima facie* obvious in view of the teachings of the prior art. The Board states that "a collective evaluation of the Wilson and the Hendrix patents would have rendered the subject matter of independent claims 1, 13, 24, and 29 obvious to one of ordinary skill." Fritch maintains that there is no teaching, suggestion, or incentive in the prior art to modify or to combine the

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¹⁰ In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

^a See *In re Lame, 837 F.2d 1071, 1074, 5 USPQ2d 147, 1598 (Fed. Cir. 1988)* (citing *In re Latu, F.2d 703, 705, 223 USPQ 1257, 1258* (Fed. Cir. 1988)).

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teachings of the prior art in the manner suggested by the Examiner. We agree. [3] Wilson teaches a grass edging and watering device which includes an anchoring leg for securing the device to the ground. Wilson contemplates that a trench will need to be dug in order to allow the anchoring leg to be placed into the ground if the condition of the soil requires it. This anchoring leg prohibits flexibility and conformability over the length of Wilson. Any flexibility or conformability in Wilson, which the Board states extends to the entire device, is limited to the mower strip. It is only the mower strip that is mentioned as being flexible in order to aid installation. Hendrix has been cited for its teaching of a flexible retainer strip that is able to conform to the ground surface.

Wilson addresses the problems of arrest-
ing growth of grass between areas and water-
ing plants without wetting sidewalks. Wilson
lacks any suggestion or incentive to use its
water conduit as a landscape retainer since
this would arguably result in clogged spring-
er heads.¹² Wilson also teaches that its
mower strip is flexible in order to allow dirt
to be packed thereunder. There is no sugges-
tion in Wilson to extend that flexibility to the
entire device. Wilson also lacks any teaching
or suggestion that one should remove the
anchoring leg. Hendrix does not, simply by
virtue of its flexible nature, suggest these
extensive changes which the Board states are
obvious. Neither Wilson nor Hendrix, alone
or in combination, provide any incentive to
combine the teachings of the prior art in the
manner maintained by the Board.

[4] “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.”¹³ Although couched in terms of combining teachings found in the prior art, the same enquiry must be carried out in the context of purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested

¹² This court has previously found a proposed

This court has previously found a proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior

int reference inoperable for its intended purpose.
1 re Gordon; 733 F.2d 900, 902, 221 USPQ
125, 1127 (Fed. Cir. 1984).

TRADEMARKS AND UNFAIR TRADE PRACTICES

- Acquisition, assignment, and maintenance of marks — Acquisition through use — Priority of use (§305.0503)

Practice and procedure in Patent and Trademark Office — Interparties proceedings — Opposition and cancellation — In general (§325.0305.01)

Infringement; conflicts between marks — Likelihood of confusion — In general (§335.0301)

Opposer which uses mark "Rescue: 911" for its television show, which asserts that it has licensed use of mark on various merchandise items, and which seeks to oppose registration of "911 Rescue Bars," for candy bars, must clearly indicate in its pleading whether its claim of likelihood of confusion is based upon its services or its collateral merchandise, or both, and whether it claims priority of use of its mark on its collateral merchandise.

Conclusion

The decision of the Board affirming the Examiner's rejection of independent claims 1, 13, 24, and 29 of Fritch's application as unpatentable over the prior art under 35 U.S.C. § 103 is reversed. Since dependent claims are nonobvious if the independent claims from which they depend are nonobvious, the Board's affirmation of the rejection of dependent claims 2-7, 9-12, 14-23, and 30 is also reversed.¹⁷

REVERSED

**U.S. Patent and Trademark Office
Trademark Trial and Appeal Board**

CBS Inc. v. Mercandante

Nos. 85,324 and 85,330

Decided June 15, 1992

Consolidated trademark oppositions no. 85,324 and 85,330, by CBS Inc. against James V. Mercandante and Rose Marie Mercandante, d/b/a 911 Rescue Bar, applications serial no 74/076,762, filed July 9, 1990, and 74/081,813, filed July 25, 1990, in which applicants counterclaim to cancel opposer's pleaded registration. On opposer's motion to amend its answer to counterclaim, and on applicant's motions to strike opposer's affirmative defenses, and for judgment on the pleadings. Motion for judgment on pleadings granted in part.

¹⁷ *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127.

¹⁸ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁹ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

²⁰ *In re Fine*, 837 F.2d at 1076, 5 USPQ2d at 1600 (citing *Hartness Int'l., Inc. v. Simplimatic Engg. Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987)). See also *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983) (when argued together, dependent claims stand or fall with the independent claims from which they depend).

David S. Fishman, Windsor, Conn., for applicants.

Marshall J. Nelson, Washington, D.C., for opposer.

Before Sams, Rice, and Quinn, members.

By the board.

James V. Mercandante and Rose Marie Mercandante filed applications to register

the opposition, although EL's statement is not in the record. The district court denied AEF's request and held that "[t]he issue of estoppel is before the Trademark tribunal not this court. If defendant believes that the plaintiffs should be prohibited from pursuing the Opposition action in the Trademark Office because of the result in this case, then defendant needs to make that argument to the Trademark Office."

[3] AEF says that district courts are given clear statutory authority over actions regarding the trademark registration process under 15 U.S.C. § 1119, which states that "[i]n any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action." AEF cites *Avon Shoe Co. v. David Crystal, Inc.*, 279 F.2d 607, 609 [125 USPQ 607] (2d Cir. 1960), which involved a dispute over the plaintiff's use of the "Haymakers" mark and the defendant's use of the "Haymaker" mark. The Second Circuit affirmed the district court's order directing the PTO to dismiss the plaintiff's opposition and grant the concurrent registration of defendant's mark. *Id.* at 614-16. This case is factually distinguishable from *Avon Shoe*, however, because the marks at issue are not the same. The issue in this case was whether AEF's activities infringed or diluted EL's "Eagles" mark; the case did not involve AEF's rights in the "American Eagles Records" mark. While the district court may have had general authority under 15 U.S.C. § 1119 to order the PTO to take action, it did not have the authority to decide issues regarding a mark that was not properly before it. See *Old Dutch Foods, Inc. v. Dan Dee Pretzel & Potato Chip Co.*, 477 F.2d 150, 157 [177 USPQ 496] (6th Cir. 1973) (directing the PTO to issue a concurrent registration to the defendant with limitations); *Durox Co. v. Duron Paint Mfg. Co.*, 320 F.2d 882, 883, 885-86 [138 USPQ 353] (4th Cir. 1963) (directing the PTO to issue a registration for the plaintiff's mark after the plaintiff properly raised the issue of validity in the complaint); *Massa v. Jiffy Prods. Co.*, 240 F.2d 702, 704, 707 [112 USPQ 241] (9th Cir. 1957) (directing the PTO to cancel the "Jiffy" mark for the plaintiff and award a registration for the same mark to the defendant).

Further, the prospect of dismissal of the PTO opposition was not properly before the district court because AEF raised the issue for the first time in its motion for reconsideration. AEF failed to raise the argument as a counterclaim to the infringement action. Hence, according to the procedural posture of the case, and by AEF's own admissions, its argument for dismissal is not based on the merits, but on an estoppel theory. As the district court correctly pointed out, estoppel issues are ordinarily enforced by awaiting a second action, which they are pleaded and proved by the party asserting estoppel. The PTO, not the district court, must determine the preclusive effect of EL's statements.

Even if the issue of estoppel was properly before the district court, however, in light of the PTO's expertise and the district court's failure to reach the merits of the underlying action in this case, the district court's decision was reasonable and not an abuse of discretion. The district court adequately articulated its reasons for denying attorney's fees and costs, applied the correct legal standard for "exceptional" cases under 15 U.S.C. § 1117(a), and in its discretion denied AEF's request for attorney's fees. The district court also did not abuse its discretion by refusing to dismiss the pending trademark opposition.

Accordingly, the district court's decision is AFFIRMED.

III. CONCLUSION

The court adequately articulated its reasons for denying attorney's fees and costs, applied the correct legal standard for "exceptional" cases under 15 U.S.C. § 1117(a), and in its discretion denied AEF's request for attorney's fees. The district court also did not abuse its discretion by refusing to dismiss the pending trademark opposition.

Accordingly, the district court's decision is AFFIRMED.

U.S. Court of Appeals (July 14, 2004)

Federal Circuit

No. 03-1333

Decided January 29, 2004

Argued October 22, 2003

Submitted November 10, 2003

PATENTS

[1] Patentability/Validity — Obviousness — Combining references (§ 115,0905) — Possible solutions to that problem.

[2] Patentability/Validity — Obviousness — Commercial success (§ 115,0908)

[3] Patentability/Validity — Obviousness — Combining references (§ 115,0905)

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prior art, since motivation to combine may be found in nature-of-problem to be solved, leading inventors to look to references relating to possible solutions to that problem.

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dant on nonpatent claims, and at trial found that patents were invalid for obviousness. Judgment of invalidity was vacated and remanded (57 USPQ2d 1161). On remand, district court again found claims invalid as obvious, and defendant appealed. Affirmed. Prior decision: 57 USPQ2d 1161.

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foundations. Fuller and Rupiper used a concrete haunch, not a metal bracket, to transfer the load of the foundation to the screw anchor (the "Fuller-Rupiper method").¹ [Footnote 1: U.S. Patent Nos. 4,911,580 and 4,765,777 claim an apparatus and system for underpinning structural foundations using a push pier and a metal bracket. In the Gregory system, the metal bracket transfers the foundation load to the push pier, which is driven into the ground to supply the necessary foundational support. The push pier relies on soil friction to supply that support. Figure 6 of the '580 patent shows this technology.]

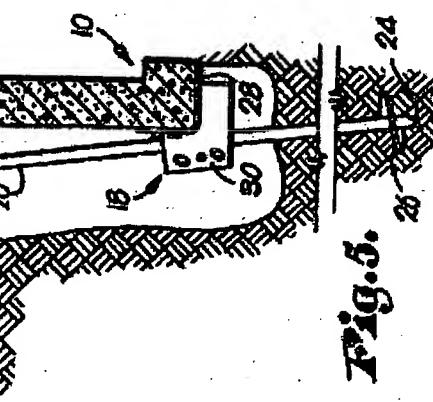


Fig. 5.

Appellees Richard Ruiz and his company Foundation Anchoring Systems, Inc. (collectively "Ruiz") became distributors for Chance's underpinning system. During the early 1990s, Ruiz also formed various other anchoring companies and marketed systems that competed with the Chance system. In February 1997, Chance terminated Ruiz's distribution. Thereafter, Ruiz began marketing an underpinning system with screw anchors and metal brackets. This new system used components from other manufacturers. Ruiz filed suit against Chance in August of that same year alleging various non-patent claims, including discrimination, breach of contract, tortious interference with contract and business relations, and breach of fiduciary duty of good faith and fair dealing. Ruiz also filed for a declaratory judgment that its new underpinning system does not infringe Chance's patents and that the patents are invalid. Chance filed a counterclaim for patent infringement.

The validity question focuses on several prior art references. During the late 1980s, Richard Fuller and Stan Rupiper used screw anchors for underpinning existing structural

shows that the Fuller-Rupiper method discloses the screw anchor component of the claims; the Gregory system discloses the metal bracket component in the claims. Thus, this appeal is properly focused on the motivation to combine those teachings, as well as any secondary considerations that might inform the obviousness analysis.

The district court granted summary judgment in favor of Chance on all of Ruiz's non-patent claims in April 1999. On the patent claims, the district court held a *Markman* hearing to construe the claims and a bench trial to decide the issues of infringement and validity. At the time of trial, the scope of the case had narrowed to focus on claims 1-4 and 6-8 of the '368 patent and claims 1-4 and 6-8 of the '107 patent. After the trial, the district court entered its judgment from the bench that Ruiz's product infringes the patent claims to the tune of \$540,000 in damages. Nonetheless, the trial court determined that the claims are invalid under 35 U.S.C. § 103 in light of the Gregory patents and the Fuller-Rupiper method.

This court heard the appeal from that judgment, and affirmed every holding of the district court, except the finding of obviousness. In Ruiz, 234 F.3d at 660, this court remanded the case to the district court for further examination of obviousness. This court issued the following instructions:

(On remand, we instruct the district court to make specific *Graham* findings on: 1) the reason, suggestion, or motivation present in the prior art, in the knowledge of one of skill in the art, or in the problem of foundation settling, which clearly and particularly would lead one of ordinary skill in the art to combine screw anchors with metal brackets; 2) the level of ordinary skill in the art; and 3) whether, and to what extent, evidence of secondary consideration, such as commercial success, long felt but unresolved need, failure of others, copying, and unexpected results, is probative in the obviousness analysis.)

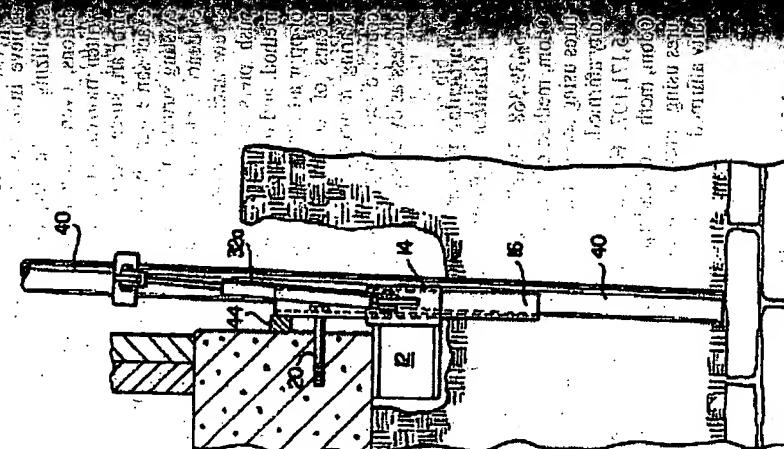


FIG. 6.

The scope of the claims in this case is not at issue in this appeal, because the parties agree that the claims are infringed or invalidated by the use of a screw anchor in conjunction with a metal bracket to underpin a foundation. Additional information concerning the claims and the other aspects of this case appear in this court's opinion in Ruiz v. A.B. Chance Co., 234 F.3d 654 [57 USPQ2d 1461] (Fed. Cir. 2000). Examination of the prior art shows that the teachings of the Gregory patents and

the Fuller-Rupiper method in the nature of the problem of underpinning foundations itself, explaining:

The Rupiper method and the Gregory patent can be combined in either of two ways to reach the same result as the method covered by the patents in issue here: by replacing the concrete haunch of the Rupiper method with the bracket of the Gregory patent, or by replacing the straight piling of the Gregory patent with the screw anchor of the Rupiper method. The evidence in this case showed that there was reason, suggestion or motivation to make these combinations. . . . The problem is the same: how to underpin an unstable foundation of an existing building.

The district court also discounted Chance's proffered objective evidence of commercial success and skepticism of experts as weak. Specifically, the district court found that the alleged skepticism of Chance's system by Rupiper was merely an acknowledgement that Rupiper's concrete haunch worked better than a metal bracket in seismic areas, such as California. The record indeed does not show that Rupiper doubted that Chance's system would work in general. In addition, the district court attributed Chance's commercial success to its background and experience in screw anchors rather than any inventive features of the screw anchor-metal bracket system as a whole.

Chance now appeals again, arguing that the district court, as it did in its original judgment, employed hindsight to find obviousness. Specifically, this appeal involves two challenges to the district court's obviousness determination: 1) whether the district court clearly erred in finding an implied motivation to combine the prior art teachings in the nature of the problem of underpinning existing foundations, and 2) whether the district court clearly erred in discounting Chance's evidence of secondary considerations. Jurisdiction over this appeal is proper under 28 U.S.C. § 1295.

II.

Section 103 of title 35 of the United States Code states:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103(a) (2000).

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envil. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 [218 USPQ 865] (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See *In re Roffler*, 149 F.3d 1350, 1355-56 [47 USPQ2d 1453] (Fed. Cir. 1998).

While the ultimate determination of obviousness is a legal conclusion reviewed by this court without deference, that determination always entails various factual findings that this court reviews for clear error following a bench trial. See *Weatherhem Corp. v. J.L. Clark, Inc.*, 163 F.3d 1326, 1332 [49 USPQ2d 1001] (Fed. Cir. 1998). The clear error standard permits reversal only when this court is left with a "definite and firm conviction" that the district court was in error. *Amtil Enters. Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1562 [38 USPQ2d 1471] (Fed. Cir. 1996).

This case deals with a challenge to the district court's conclusion on two of the underlying factual determinations in its obviousness analysis. Accordingly, this court will review

for clear error the district court's conclusions regarding objective, secondary considerations. See *Pro-Mold v. Great Lakes Plastics*, 75 F.3d 1568, 1572 [37 USPQ2d 1626] (Fed. Cir. 1996), and whether a motivation to combine the teachings in the prior art references, was shown, see *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 [53 USPQ2d 1580] (Fed. Cir. 2000).

The district court in this case presided over a bench trial and reconsidered the evidence on remand. Chance's principal argument is that the district court clearly erred in finding a motivation to combine the teachings in the Fuller-Rupiper methodology with the Gregory system to underpin the risk of hindsight. Chance cites this court's precedent that, warn district courts about the risk of hindsight by construction to find an invention "obvious" where the invention involves relatively simple technology. See *McGhie & Franklin Sports, Inc.*, 262 F.3d 1339, 1354 [60 USPQ2d 1001] (Fed. Cir. 2001). Accordingly, Chance argues that the district court utilized hindsight to find that a person of ordinary skill would have been motivated to combine the prior art teachings.

[1] To the contrary, the record in this case supports the trial court's findings. While the court indeed warns against employing hindsight, its counsel is just that – a warning. That warning does not provide a rule of law that appears in prior art references before a finding of obviousness. Stated differently, this court has consistently stated that a court or examiner may find a motivation to combine prior art references in the nature of the problem to be solved. See *Pro-Mold*, 75 F.3d at 1573; *Disp Techs., Inc. v. Paul Flum Ideas Inc.*, 282 F.3d 1340, 1346-47 (Fed. Cir. 2002); *In re Huang*, 100 F.3d 135, 139 n.5, [40 USPQ2d 1683] (Fed. Cir. 1996). This form of motivation to combine evidence is particularly relevant with simpler mechanical technologies.

[2] This record shows that the district court did not use hindsight in its obviousness analysis, but properly found a motivation to combine the two references address precisely the same problem of underpinning existing structural foundations. Moreover, the record supports the district court's factual finding that Fuller's and Rupiper's work showed that screw anchors worked better than straight push piers. In fact, the evidence shows that Rupiper introduced Chance to the use of screw anchors in underpinning building foundations. Chance then added a metal bracket to the screw anchor.

spite record also supports the district court's conclusion that artisans knew that a foundation underpinning system requires a means of connecting the foundation to the load-bearing member. The Gregory patents teach the use of a metal bracket to connect a foundation to a straight pier, and testimony at trial showed that the need for a connecting element was widely known. Thus, the district court could properly conclude on this record, without being clearly in error, that a person of ordinary skill would be led to combine the screw anchor bracket in the Gregory system to underpin an existing building foundation.

[3] This record, it is true, does not feature an express written teaching in the art to make this combination. On this record, however, that is not fatal to the district court's obviousness determination. As noted earlier, this court has repeatedly stated that the motivation to combine the teachings in the prior art may "come from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem." *Pro-Mold*, 75 F.3d at 1573. The district court in this case applied this settled law. The district court, citing as a matter of fact, weighed the evidence and found that because the prior art references addressed the narrow problem of underpinning existing building foundations, a person seeking to solve that exact same problem would consult the references and apply their teachings together. Thus the district court's conclusion is perfectly legitimate when the evidence supports it, as it does here.

[4] Chance's argument amounts to little more than his own alternative view of the evidence. While the record does contain some evidence against the district court's finding, such evidence is not overwhelming by any means. In addition, the district court in this case did not simply discount all contrary evidence and bolster a meager amount of evidence to reach a preformed conclusion. In fact, the district court discounted and discredited some testimony that actually supported its ultimate conclusion. For instance, the trial court dismissed the testimony of Robert Jones, a Chance distributor, that he would have made the combination. The district court declined to credit Mr. Jones' testimony because he exhibited far more an ordinary level of skill in this art. The trial court's careful consideration of Mr. Jones' evidence shows further that it performed a detailed and reasoned analysis of the evidence, rather than a conclusion-oriented discussion that typically accompanies a hind-

sight analysis. In short, the record in this case does not approach the evidence necessary to leave this court with a firm conviction that the district court committed clear error in its factual finding of a motivation to combine the Fuller-Rupiper and Gregory teachings.

Finally, the record also supports the district court's discounting of Chance's evidence of secondary considerations. The record supports the trial court's finding that any commercial manufacturer to enter the underpinning market. The district court did not clearly err in reaching this conclusion, nor in concluding that the evidence of skepticism was weak.

III.

Based on the above analysis, this court holds that the district court did not clearly err in finding a motivation to combine the prior art references in the nature of the problem at issue. In addition, this court holds that the district court did not clearly err in discounting Chance's evidence of secondary considerations. Accordingly, this court affirms the judgment of the district court.

COSTS

Each party shall bear its own costs.

AFFIRMED

Motorvac Technologies Inc. v. Norco Industries Inc.

**U.S. District Court
Central District of California**
No. SACV 02-503 DOC (ANX)
Decided January 12, 2004

PATENTS

[1] Infringement — Defenses — Estoppel; Laches (§ 120,1103)

Accused infringer moving for summary judgment that infringement claim is barred by laches has not provided affirmative evidence that patentee's delay of three and one-half years in filing suit was unreasonable, since such delay is not excessive on its face, and since, in undertaking reexamination of its